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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/420,334	10/18/1999	STEVEN D. LACY	98-11CIP1RCE	2647

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SYMYX TECHNOLOGIES INC
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EXAMINER

MARSCHEL, ARDIN H

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/420,334

Applicant(s)

LACY ET AL.

Examiner

Ardin Marschel

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,11-14,19,21-24,27,29,37,39-45,47-50,55,57-60,63,65 and 91-100 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date (1 sheet).
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims pending in the application are 1,3-9,11-14,19,21-24,27,29,37,39-45,47-50,55,57-60,63,65 and 91-100.

DETAILED ACTION

Applicants' arguments, filed 11/5/04, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

VAGUENESS AND INDEFINITENESS

Claims 1, 3-9, 11-14, 19, 21-24, 27, 29, 37, 39-45, 47-50, 55, 57-60, 63, 65, and 91-100 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 5, cites the defining of one or more destinations. This is interpreted as being inclusive of one destination which is therein defined. In claim 1, line 15, the limitation "defined destinations" is set forth. This indicates a plurality of destinations only without the option of one destination. Thus, the metes and bounds of claim 1 are vague and indefinite because the number of destination(s) cited in line 5 does not correspond to the claimed mapping practice in lines 12-20 which only cites plural destinations. Similarly, claims 3 and 4, for example, cite defining plural destinations whereas both singular and plural destinations are defined in said line 5 of claim 1. This unclarity is equivalently present also in independent claims 19, 37, and 55 and claims dependent from claims 1, 19, 37, and 55 due to their dependence. Clarification via clearer claim wording is requested.

PRIOR ART

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3-9, 11-14, 19, 21-24, 27, 29, 37, 39-45, 47-50, 55, 57-60, 63, 65, and 91-100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flavin et al. (P/N 6,044,212); taken in view of Schultz et al. (P/N 6,004,617); taken further in view of Agrafiotis et al. (P/N 6,295,514).

The description of the basic invention involving computerized combinatorial library design including a gradient and equations for defining components therein as set forth in the combination of Flavin et al. taken in view of Schultz et al. has been set forth in previous office actions and is reiterated specifically from the previous office action, mailed 5/5/04. This combination, however, lacks the present limitations directed to a graphical user interface practice as well as modifying visual representations of defined destinations to indicate calculated amounts.

Agrafiotis et al. is also directed to computer design of a set of compounds as a combinatorial library via non-linear mapping as summarized therein in column 1, line 21, through column 2, line 34. It is noted that the gradient practice of the instant claims are also a non-linear compound mapping scheme. Agrafiotis et al. additionally summarizes a graphical user interface for such design practice as summarized in column 15, line 1, through column 17, line 43. The updating or modifying ability of such an interface is described in column 16, lines 45-59, as also instantly claimed such as in claim 1, last 2 lines, for example. Agrafiotis et al. indicates that someone skilled in the art appreciates the flexibility etc. of such a user interface in column 17, lines 2-11. This is reasonably interpreted as generic motivation and suggestion to utilize such an interface in order to obtain the benefits of flexibility etc. as set forth in Agrafiotis et al.

Thus, it would have been obvious to someone of ordinary skill in the art at the time of the instant invention to utilize a graphical user interface, motivated by benefits such as flexibility etc. as set forth in Agrafiotis et al. to improve on the combinatorial library design practice of the combination of Flavin et al. with Schultz et al. to result in the practice of the instant invention.

OBVIOUSNESS TYPE DOUBLE PATENTING

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3-9, 11-14, 19, 21-24, 27, 29, 37, 39-45, 47-50, 55, 57-60, 63, 65, and 91-100 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 89-104 of copending Application No. 09/174,856. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to methods of visualizing combinatorial library design using a graphical user interface which may be modified. The instant claims are more specific than the generic claims of the copending application serial number 09/174,856 which thus supports this rejection as one way anticipatory double patenting. See the MPEP at section 804, (II), (B), (1), (a).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (571) 273-8300.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., AU 1631 Supervisory Patent Examiner, whose telephone number is (571) 272-0718. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (571) 272-0549.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 21, 2005

Ardin H. Marschel 3/21/05
[Stamp]